

REMARKS

I. Introduction

Claims 16 and 17 have been canceled, without prejudice, therefore, claims 15 and 18 to 31 are pending in the present application. Claims 15 and 29 have been amended, without prejudice. Entry of the amendments is respectfully requested since they raise no new issues: amendments to claim 15 essentially amount to rewriting of claim 17 in independent format, and amendments to claim 29 substantially correspond to the amendments made to claim 15. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable and reconsideration is respectfully requested.

II. Rejection of Claims 15 to 18, 23, and 28 to 31 Under 35 U.S.C. § 103(a)

Claims 15 to 18, 23, and 28 to 31 were rejected under 35 U.S.C. § 103(a) as unpatentable over United States Patent No. 6,473,609 (“Schwartz”) in view of United States Patent No. 6,08873,594 (“Kingdon”). Applicants respectfully submit that this rejection should be withdrawn for the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 15 has been amended to recite a method for transmitting messages between at least one main station and a terminal via a telecommunications network, including providing a matching device between the at least one main station and the terminal, controlling a message exchange using the matching device, the message exchange being controlled in

dependence upon at least one input from one of: i) the terminal, and ii) the at least one main station, wherein the message is transmitted in a format that is determined in dependence upon a format request made by one of the terminal and the at least one main station, and **matching, by a matching device, at least one characteristic for transmission of a message to the at least one input, wherein the at least one characteristic is at least one of a data type, a data format and a transmission mode.**

Claim 29 has been amended to recites a matching device for transmitting messages between at least one main station and terminal via a telecommunications network, including at least one interface to the at least one main station, an interface to the terminal, a storage device configured to store at least one input from one of the terminal and the at least one main station for controlling a message exchange between the at least one main station and the terminal, a control unit configured to control the message exchange as a function of the at least one input, wherein the at least one input includes a format request made by one of the terminal and the at least one main station, and **a matching device configured to match at least one characteristic for transmission of a message to the at least one input, wherein the at least one characteristic is at least one of a data type, a data format and a transmission mode.**

Claim 30 recites a method for transmitting messages between at least two main stations and a terminal via a telecommunications network, including providing a matching device between **the at least two main stations** and the terminal, and controlling a message exchange using the matching device, the message exchange being controlled in dependence upon at least one input from one of: i) the terminal, and ii) the at least two main stations.

Claim 31 recites a matching device for transmitting messages between **at least two main stations** and a terminal via a telecommunications network, including at least one interface to at least one of the at least two main stations, an interface to the terminal, a storage device configured to store at least one input from at least one of the terminal and the at least two main stations for controlling a message exchange between **the at least two main stations** and the terminal, and a control unit configured to control the message exchange as a function of the at least one input.

Schwartz discusses navigation of the Internet by two-way interactive communication mobile devices that are capable of wireless communication on the Internet via

a link server with service providers or network servers. (Schwartz, Abstract.) According to Schwartz, a control engine in a link server is used to transmit data in a compact data format to an interface engine of a mobile device causing the mobile device to display contents of the markup language files on a display screen. (Schwartz, Abstract; Figure 9C; col. 2, lines 58 to 67; col. 4, lines 9 to 24; col. 9, lines 29 to 58.) The Schwartz system merely compresses markup language files into screen description data (SDD) files, which cause text of the markup language file contents to be displayed on the screens of mobile devices.

In contrast to Schwartz, the present invention facilitates conversion of, for example, "text to voice mail or text to fax." (Substitute Specification, page 10, lines 23 to 32.) Therefore, the matching device of the present invention will convert messages, e.g., "according to an input from a main station addressed by these messages, to a format requested by this main station." (Substitute Specification, page 10, lines 23 to 32.) In this manner, the present invention is clearly different from merely compressing markup language files into SDD files as done in the Schwartz system. None of the passages of Schwartz cited in the Office Action disclose, or even suggest, that the message is transmitted in a format that is determined in dependence upon a format request made by one of the terminal and the at least one main station, nor do the passages of Schwartz disclose, or even suggest, **matching, by the matching device, at least one characteristic for transmission of a message to the at least one input, wherein the at least one characteristic is at least one of a data type, a data format and a transmission mode**, as recited in claim 15. Applicants will discuss below various individual passages of Schwartz in support of Applicants' position.

Col. 3, lines 38 to 55 of Schwartz merely state that, according to one embodiment, the control engine is initiated when the mobile device establishes a communication session with the link server, after which the control device eventually converts a message to "a compact data file that can be easily transportable in the wireless network." It is noted that this passage does not provide any details or explanation of what controls the establishing of the communication session.

Similarly, col. 5, lines 47 to 61 of Schwartz merely state that a link server 114 functions as a bridge between landnet 100 and airnet 102, and that the link server may map or translate from one communication protocol in landnet to another in airnet or vice versa. Col. 7, lines 55 to 62 of Schwartz merely state that an account manager manages a number of user

accounts for all the mobile devices and that each mobile device is assigned an ID number, such as a phone number or IP address. Col. 9, lines 29 to 41 of Schwartz merely state that since the mobile device typically does not have the necessary computing power to operate a browser in response to an HDML file, a message digester initially analyzes the file and a converter subsequently converts the file “into a set of screen commands that cause a mobile device, upon receiving the screen commands to display the contents in the HDML file according to the screen commands,” which are typically expressed in SDD form.

Col. 10, lines 35 to 53 of Schwartz merely state that a mobile device may be identified by a device ID and include a client module that performs processing tasks, such as establishing a communication session with the line server, and requesting and receiving data from the from a carrier network. It is noted that this passage of Schwartz does not include any details or explanation regarding the control of how the client module requests data or what the request includes.

Col. 11, lines 4 to 9 of Schwartz merely state that the mobile device communicates with a network server via a link server device, and that the network server may be any server on the Internet that provides accessible hypermedia information. It is noted that this passage does not provide any details or explanation of what controls the establishing of the communication session.

Col. 13, lines 25 to 38 of Schwartz merely state that when a user presses a predetermined key on the mobile device, the client module sends a request to the link server to display the next screen display, and that the control engine calls the converter to convert an HDML card to an SSD file. Col. 13, lines 64 to 66 merely state that each of the menus shown on the screen display is available on a service server or distributed on several server computers coupled to a network.

Col. 14, lines 10 to 58 of Schwartz merely state that the user may select from menu items displayed on the display screen using the keys, such as the number keys, which cause the client module in the mobile device to send a new request to the link server for a next screen display. This request may include a resource locator to another card cached in the link server or to a hyperlink of a URL in the card that has been converted to the SDD file currently being displayed. This passage does not disclose, or even suggest, at least one characteristic for transmission of a message to the at least one input, wherein the at least one characteristic is

at least one of a data type, a data format and a transmission mode.

As can be seen from the above discussions, Schwartz does not disclose, or even suggest, that the message is transmitted in a format that is determined in dependence upon a format request made by one of the terminal and the at least one main station, nor does Schwartz disclose, or even suggest, matching, by a matching device, at least one characteristic for transmission of a message to the at least one input, wherein the at least one characteristic is at least one of a data type, a data format and a transmission mode.

Regarding claims 29, the Office Action cites several passages similar to those cited against claim 15 (some of the passages include or overlap those listed against claim 15), and it is respectfully submitted that, at least partly for the reasons stated in connection with claim 15, none of these passages of Schwartz disclose, or even suggest, a control unit configured to control the message exchange as a function of the at least one input, wherein the at least one input includes a format request made by one of the terminal and the at least one main station; and a **matching device configured to match at least one characteristic for transmission of a message to the at least one input, wherein the at least one characteristic is at least one of a data type, a data format and a transmission mode**, as recited in claim 29.

Kingdon does not cure the deficiencies of Schwartz as applied against claims 15 and 29. While the Examiner cites col. 4, lines 9-55 of Kingdon as disclosing that "the message is transmitted in a format that is determined in dependence upon a format request made by one of the terminal and the at least one main station," there are at least two flaws with the Examiner's assertion. First, Kingdon provides that the term "format" refers to the contents of the information desired by the mobile station, such as the street address, location on a map, etc. (Col. 4, lines 46-53). This "format" mentioned in Kingdon has nothing to do with the "characteristic for the transmission of the message" recited in claims 15 and 29. Furthermore, it is stated in Kingdon that the TCP/IP Protocol specifies the addressing of **nodes of the Internet** and provides a method for transmission of data packets from one node to another node. Internet nodes represent purely transmission-technology units used as switching exchanges that are required for the routing of the information to be transmitted via the Internet. Therefore, Internet nodes are not equivalent to the claimed "main stations," as recited in claims 15 and 29. Therefore, the combination of Kingdon and Schwartz fails to

disclose, or even suggest, all of the features of claims 15 and 29.

Regarding claim 30 and 31, these claims recite a method and a device, respectively, for transmitting messages between at least two main stations. While the Office Action concedes on page 9 that Schwartz does not disclose at least two main stations, the Office Action also asserts that Kingdon purportedly teaches at least two main stations in "discussing connection of a mobile to one [or] more servers on the internet via the internet addresses," at col. 4, lines 38-45. However, as stated above, Kingdon states that the TCP/IP Protocol specifies the addressing of nodes of the Internet and provides a method for transmission of data packets from one node to another node. As mentioned previously, Internet nodes represent purely transmission-technology units used as switching exchanges that are required for the routing of the information to be transmitted via the Internet, and therefore, Internet nodes are not equivalent to the claimed "main stations" recited in claims 30 and 31. Therefore, Schwartz and Kingdon, either individually or in combination, fail to disclose, or even suggest, a method or a device for transmitting messages between at least two "main stations," as recited in claims 30 and 31. It is therefore respectfully submitted that it would not have been obvious to modify the invention of Schwartz as suggested on page 11 of the Office Action, because Kingdon does not disclose, or even suggest, at least two "main stations."

For the foregoing reasons, it is respectfully submitted that claims 15, 29, 30 and 31 are allowable over the combination of Schwartz and Kingdon. Claims 16 and 17 have been cancelled, therefore the rejection is moot as to those claims. As for claims 18, 23 and 28, all of which ultimately depend from claim 15, and therefore include all of the features of claim 15, it is respectfully submitted that claims 18, 23 and 28 are allowable for at least the same reasons given above in connection with claim 15. It is therefore respectfully requested that this rejection of pending claims 15, 18, 23, and 28 to 31 be withdrawn.

III. Rejection of Claims 19, 20 and 22 Under 35 U.S.C. § 103(a)

Claims 19, 20 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,473,609 ("Schwartz") in view of United States Patent No. 6,08873,594 ("Kingdon") and in further view of United States Patent No.

6,138,158 ("Boyle"). Applicants respectfully submit that this rejection should be withdrawn for the following reasons.

As recited above, the combination of Schwartz and Kingdon does not disclose, or even suggest, all of the features of claim 15, from which claims 19, 20 and 22 depend, e.g., the limitation of "matching, by the matching device, at least one characteristic for transmission of a message to the at least one input, wherein the at least one characteristic is at least one of a data type, a data format and a transmission mode."

The Office Action merely cites Boyle for disclosing the following features: "if the terminal cannot be reached, storing the message until the matching device recognizes that the terminal can be reached"; "notifying the terminal of the availability of the message by the matching device, when the terminal cannot be reached"; and "segmenting, by the matching device as a function of the input from the terminal individual parts of a message, which includes a plurality of elements, and processing the message by the matching device." Without passing judgment on the merits of the Examiner's contentions regarding Boyle, it is respectfully submitted that Boyle also does not disclose, or even suggest, the above features of claim 15 that are not disclosed by the combination of Schwartz and Kingdon, i.e., "matching, by the matching device, at least one characteristic for transmission of a message to the at least one input, wherein the at least one characteristic is at least one of a data type, a data format and a transmission mode."

For the foregoing reasons, it is respectfully submitted that claims 19, 20 and 22, all of which depend from claim 15, and therefore include all of the features of claim 15, are allowable over the combination of Schwartz, Kingdon and Boyle. It is therefore respectfully requested that this rejection of claims 19, 20 and 22 be withdrawn.

IV. Rejection of Claim 21 Under 35 U.S.C. § 103(a)

Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,473,609 ("Schwartz (A)") in view of United States Patent No. 6,08873,594 ("Kingdon") and in further view of United States Patent No. 6,243,739 ("Schwartz (B)"). Applicants respectfully submit that this rejection should be withdrawn for the following reasons.

As indicated above, the combination of Schwartz (A) and Kingdon does not disclose, or even suggest, all of the features of claim 15, from which claim 21 depends, e.g., the limitation of "matching, by the matching device, at least one characteristic for transmission of a message to the at least one input, wherein the at least one characteristic is at least one of a data type, a data format and a transmission mode."

The Office Action cites Schwartz (B) for disclosing the following: "transmitting a plurality of messages, from different ones of the at least one main station, in a combined form to the terminal by the matching device." Without passing judgment on the merits of the Examiner's contentions regarding Schwartz (B), it is respectfully submitted that Schwartz (B) does not disclose, or even suggest, the above features of claim 15 that are not disclosed by the combination of Schwartz (A) and Kingdon, i.e., "matching, by the matching device, at least one characteristic for transmission of a message to the at least one input, wherein the at least one characteristic is at least one of a data type, a data format and a transmission mode."

For the foregoing reasons, it is respectfully submitted that claim 21, which depends from claim 15, and therefore includes all of the features of claim 15, is allowable over the combination of Schwartz (A), Kingdon and Schwartz (B). It is therefore respectfully requested that this rejection of claim 21 be withdrawn.

V. Rejection of Claims 24 to 27 Under 35 U.S.C. § 103(a)

Claims 24 to 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,473,609 ("Schwartz") in view of United States Patent No. 6,08873,594 ("Kingdon") and in further view of United States Patent No. 6,560,640 ("Smethers"). Applicants respectfully submit that this rejection should be withdrawn for the following reasons.

As indicated above, the combination of Schwartz and Kingdon does not disclose, or even suggest, all of the features of claim 15, from which claims 24 to 27 depend, e.g., the limitations of "matching, by the matching device, at least one characteristic for transmission of a message to the at least one input, wherein the at least one characteristic is at least one of a data type, a data format and a transmission mode."

The Office Action explicitly admits that Schwartz does not disclose the features of claims 24 to 27. Smethers is merely cited for purportedly teaching the features of claims 24 to 27. Therefore, the Office Action does not even allege that Smethers discloses, and it is respectfully submitted that Smethers does not disclose, or even suggest, the above features of claim 15 that are not disclosed by the combination of Schwartz and Kingdon, i.e., the limitations of "matching, by the matching device, at least one characteristic for transmission of a message to the at least one input, wherein the at least one characteristic is at least one of a data type, a data format and a transmission mode."

For the foregoing reasons, it is respectfully submitted that claims 24 to 27, which depend from claim 15, and therefore include all of the features of claim 15, are allowable over the combination of Schwartz, Kingdon and Smethers. It is therefore respectfully requested that this rejection of claims 24 to 27 be withdrawn.

VI. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: 2/25/04

By: Richard L. Mayer
Richard L. Mayer
Reg. No. 22,490

One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646